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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,808	05/05/2005	Toyoaki Kurihara	271534US0PCT	4297
22850	7590	07/02/2007	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MULLIS, JEFFREY C	
		ART UNIT	PAPER NUMBER	
		1711		
		NOTIFICATION DATE	DELIVERY MODE	
		07/02/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/533,808	KURIHARA ET AL.	
	Examiner	Art Unit	
	Jeffrey C. Mullis	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 May 2006.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-12 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5-5-05</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 10-12 are objected to since the claim 1 from which they ultimately depend recite a powder form while claims 8-10 recite a molded product and thus the powder feature is lost. MPEP 608.01(n) does not permit dependent claims which could conceivably be infringed without infringing the base claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7, 8 and 10-12 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Matyjaszewski et al. (US 6,627,314).

Patentees in Example 11 disclose PMMA-polybutylacrylate diblock “particles” which pass through a 0.2 micron filter which is 72 mole % PMMA and in which the molecular weight of the polybutyl acrylate block is 8,290. With re to claims 10-12 reciting molding by particular method, patentees form castings (abstract) and applicants are claiming a product not a process. While applicants characteristics are not explicitly disclosed these are assumed inherent.

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Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Webster's Ninth new Collegiate Dictionary, p 922, cited of interest, defines "powder" as "matter in a finely divided state:particulate matter" as well as "a preparation in the form of fine particles".

Claims 1-5, 7, 8, and 10-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Such et al. (US 2006/0223936).

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Patentees disclose a process in which a macro RAFT agent containing polyacrylate blocks is polymerized with methacrylate monomers in a process in which the RAFT blocks are bound inherently to blocks produced from the added monomers (paragraphs 33 and 132). Note for instance Example 1b where an acrylate ester containing RAFT agent is polymerized with methylmethacrylate monomer to form 40nm particles and note numerous similar examples which disclose similar particle sizes. Note that the particulate form may be maintained on drying at paragraph 113. Patentees examples in which acrylate ester-block-methacrylate containing ester block copolymers would reasonably appear to inherently have applicants characteristics as all features of the claimed invention are present although applicants characteristics are not explicitly disclosed. With re to applicants product claims reciting molding, these claims encompass for instance molding processes in which a film is molded to a surface as a coating and as the patent discloses coatings, the products of the publication and claims reasonably appear to be the same.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference

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between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 1-5, 7, 8 and 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Uchiumi et al (US 6,329,480).

Uchiumi et al. in Examples 14 and 15 disclose diblock copolymers having an acrylate ester block and a methacrylate ester block as required by the claims with molecular weights within the range of those disclosed by applicants and as viscosity is associated with melt or solution states, the lack of powder form is immaterial to the question of whether or not applicants characteristics are inherent in the patent. Due to the similarity of applicants and patentees structures, applicants and patentees characteristics reasonably appear to be the same. Note columns 12 and 13 where it is disclosed that acrylate ester block-methacrylate ester-block-acrylate ester triblock copolymers can be produced. Note the paragraph bridging columns 19 and 20 for use

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of the materials as molding resins. While particular molding processes are not disclosed, claims 8 and 10-12 are drawn to a product, not a process. Applicants may argue that the materials of patentees are not powders which is true. However, it appears that applicants view their claims as encompassing not only actual powders but molded powders (as evidenced by the dependent claims which presumably take all the limitations of the independent claims, a form in which no powder character remains.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiumi et al. (US 6,329,480) in view of Hikasa et al. (US 5,308,699)

Uchiumi et al. in Examples 14 and 15 disclose diblock copolymers having an acrylate ester block and a methacrylate ester block as required by the claims with molecular weights within the range of those disclosed by applicants and as viscosity is associated with melt or solution states, the lack of powder form is immaterial to the question of whether or not applicants characteristics are inherent in the patent. Due to the similarity of applicants and patentees structures, applicants and patentees characteristics reasonably appear to be the same. Note columns 12 and 13 where it is disclosed that acrylate ester block-methacrylate ester-block-acrylate ester triblock copolymers can be produced. Note the paragraph bridging columns 19 and 20 for use of the materials as molding resins. While particular molding processes are not disclosed, claims 8 and 10-12 are drawn to a product, not a process.

Hikasa et al. discloses a thermoplastic elastomer in powder form with characteristics encompassing those of applicants (column 4, lines 29-35) in which a mold can be sprayed for forming complicated shapes without pinholes and having good appearance(column 3, lines 29-40 and column 4, lines 29-35, column 5, lines 1-3).

The primary reference does not disclose powder form or slush molding. However, it would have been obvious to a practitioner having an ordinary skill in the art to use the material of the primary reference in powder form having applicants characteristics and to use slush molding motivated by the disclosure of the primary

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reference that molded objects should be formed from the composition and by the secondary references disclosure that formation of a powder with applicants characteristics facilitates slush molding which results in molded objects with particularly good appearance and can be used even when making complicated shapes absent any showing of surprising or unexpected results.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis M-F, 9-5 pm at telephone number 571 272 1075.

Jeffrey C. Mullis
Primary Examiner
Art Unit 1711

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Primary Examiner
Art Unit 1711

